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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,177

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G30-016

7585

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05/01/2009

EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

05/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/687,177	Applicant(s) NAKAO, NAOMI L.	
	Examiner MATTHEW J. KASZTEJNA	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,10,12,13,17-20,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,10,12,13,17-20 and 30 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 13, 2009 has been entered.

Notice of Amendment

In response to the amendment filed March 13, 2009, amended claims 1, 10 and 46 are acknowledged. The following new grounds of rejection are set forth:

Claim Objections

Claims 1 and 10 are objected to because of the following informalities: the claims should be punctuated with a colon following the word "comprising" in the first line of each of the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 12-13, 20, 30 and 45-46 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,944,654 to Crawford.

In regards to claim 1, Crawford discloses a flexible endoscope comprising a flexible elongate insertion shaft 14 incorporating an image-carrying component or image guide taken from the group consisting of a fiber-optic bundle and an electric cable (See Col. 1, Lines 20-45 and Col.3, Lines 16-27), the insertion shaft being formed having an outer surface with at least one longitudinally extending slotted channel 20 having a first transverse dimension or diameter 26, the slotted channel having a longitudinally extending slot through the outer surface, the slot having a second transverse dimension or width 24, the second transverse dimension or width being smaller than the first transverse dimension or diameter (see Fig. 2 and Col. 3, Lines 49-54), further comprising at least one closure member 30 removably connected to the insertion shaft to close the slot, the insertion shaft being formed with a pair of opposing edges along the slot, the closure member being an elongate strip removably attached to the insertion shaft at the edges (see Col. 4, Lines 20-23), the slotted channel having a substantially circular cross-section with a circumference, the closure member completing the circumference of the slotted channel by being substantially disposed along the circumference of the circular cross-section (see Figs. 2 and 6 and Col. 3, Lines 60-65).

In regards to claim 3, Crawford discloses an apparatus wherein said channel has a distal end opening and proximal end opening, said slot extending from said distal end opening to said proximal end opening, said closure member closing said slot while maintaining said distal end opening and said proximal end opening unobstructed (see Fig. 1).

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In regards to claims 12-13, Crawford discloses a flexible endoscope, further comprising a catheter 30 disposed in the channel (see Figs. 1-2 and Col. 3, Lines 15-40).

In regards to claim 20, Crawford discloses a flexible endoscope, wherein the channel extends from a proximal end portion of the insertion shaft to a distal tip thereof (See Fig. 1).

In regards to claim 30, Crawford discloses a flexible endoscope, wherein the closure member is slidably connected to the insertion shaft, the closure member being provided with an entrainment element for facilitating manipulation of the closure member to slide the closure member along the slot (see Col. 4, Lines 15-65).

In regards to claims 45-46, Crawford discloses a flexible endoscope, wherein the insertion shaft has a first outer surface and the closure member has a second outer surface, the second outer surface being smoothly continuous with the first outer surface (see Figs. 2 and 5-6).

Claims 10 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,646,722 to Silverstein et al.

In regards to claim 10, Silverstein et al. disclose a flexible video endoscope comprising a flexible elongate insertion shaft 12 incorporating a video-image-carrying component (see Col. 5, Lines 1-15), said insertion shaft being formed along an outer surface with at least one longitudinally extending channel 21 having a first transverse dimension or diameter, said channel having a longitudinally extending slot through said outer surface, said slot having a second transverse dimension or width, said second

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transverse dimension or width being smaller than said first transverse dimension or diameter (see Fig. 3), further comprising at least one closure member 30/48 removably connected to said insertion shaft to close said slot, said insertion shaft being formed with a pair of opposing edges along said slot, said closure member being removably and slidably attached to said insertion shaft at said edges (see Col. 6, Lines 58-67), said channel having a substantially circular cross-section (see Col. 6, Lines 25-28), said closure member being configured to not protrude into said channel and to substantially maintain said circular cross-section (see Figs. 2-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,944,654 to Crawford in view of U.S. Patent No. 6,585,642 to Christopher.

In regards to claims 17-19, Crawford discloses a flexible endoscope comprising a flexible elongate insertion shaft 14, the insertion shaft is formed having an outer surface with at least one longitudinally extending channel 20 having a first transverse dimension or diameter, the channel having a longitudinally extending slot through the outer surface, the slot 24 having a second transverse dimension or width, the second transverse dimension or width being smaller than the first transverse dimension or

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diameter (see Col. 3, Lines 49-54), further comprising at least one closure member removably connected to the insertion shaft to close the slot, the insertion shaft being formed with a pair of opposing edges along the slot, the closure member being removably attached to the insertion shaft at the edges (see Figs. 1-2 and Col. 4, Lines 45-65). Crawford is silent with respect to wherein at a proximal end the channel terminates at an entry port bifurcated with respect to and diverging from the shaft, further comprising a biopsy channel liner removably disposed in the channel and extending at a proximal end out of the entry port, an end cap being fitted to the liner at the entry port. Christopher discloses an analogous apparatus having a suction tube connector 44 that is attached at the proximal end of the suction tube 40 as shown in FIGS. 3 and 1. This suction tube connector 44 has an interior airway in communication with the lumen of the suction tube 40 and a vent opening 46 leading from the interior airway to the ambient atmosphere. It would have been obvious to one skilled in the art at the time the invention was made to include an entry port bifurcated with respect to and diverging from the shaft in the apparatus of Crawford to allow for various instruments to be passed within the channel as taught by Christopher.

Allowable Subject Matter

Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 10, 12-13, 17-20, 30-31 and 45-46 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J Kasztejna/
Examiner, Art Unit 3739
4/29/09

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